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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/850,991      | 05/08/2001  | Jens Kossmann        | GFB-7 DIV           | 3510             |

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FISH & NEAVE  
1251 AVENUE OF THE AMERICAS  
50TH FLOOR  
NEW YORK, NY 10020-1105

EXAMINER

FOX, DAVID T

ART UNIT PAPER NUMBER

1638

DATE MAILED: 09/16/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/850,991

Applicant(s)

Korsman et al

Examiner

FOX

Group Art Unit

1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 5/8/01 + 1/26/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1, 9, 15-16 and 21-33 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1, 9, 15-16 and 21-33 are subject to restriction or election requirement.

## Applicant Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1638

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 16, 22-26 and 28, drawn to an antisense nucleic acid construct and plants transformed therewith, classified in class 800, subclass 286, for example.
- II. Claim 9, drawn to an isolated protein, classified in class 530, subclass 370, for example.
- III. Claims 15 and 21, drawn to a starch isolated from a plant transformed with a sense nucleic acid construct which overexpresses a debranching enzyme, and methods for its use in making foodstuffs, classified in class 426, subclass 549, for example.
- IV. Claim 27, drawn to starch isolated from a plant transformed with an antisense nucleic acid construct for inhibition of a debranching enzyme, classified in class 536, subclass 102, for example.
- V. Claims 29-33, drawn to a ribozyme-encoding construct and plants transformed therewith, classified in class 536, subclass 24.5, for example.

The inventions are distinct, each from the other because:

Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different effects.

The inventions of Groups I and V involve isolated nucleic acid constructs, methods of plant transformation and regeneration, and methods for measurement of gene inhibition, each not

Art Unit: 1638

required by any other group. The invention of Group I involves an antisense construct not required by Group V, while Group V requires a ribozyme-encoding construct not required by Group I.

The invention of Group II involves isolated protein not required by any other group. Furthermore, the protein cannot be made by expression of the nucleic acid constructs of either Groups I or V, but can be made by chemical synthesis or isolation from wild-type plants.

The inventions of Groups III and IV involve isolated starch not required by any other group. Furthermore, the starch of Group III would be biochemically and physiologically distinct from that of Group IV, given the over- or under-expression of the debranching enzyme in the plants from which each starch was obtained. In addition, the starches of Groups III or IV can be made by a process other than isolation from genetically engineered plants, such as isolation from mutant plants or chemical treatment of wild-type starch. Finally, the invention of Group III requires food processing substrates and processes not required by any other group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

Art Unit: 1638

amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

September 11, 2002

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP ~~180~~ 1638

